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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED: September 30, 1991

Paper No. 12

In re application of
Chung-Wai Chiu et al.
Serial No. 07/525,943

For: BULKING AGENTS AND PROCESSES
FOR PREPARING THEM FROM FOOD
GUMS

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: Decision on Petition
:
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Applicants have filed a petition on September 24, 1991, under 37 CFR 1.181, requesting supervisory intervention regarding the examiner's denial of the conversion request to correct the inventorship, under 37 CFR 1.48(a), filed April 19, 1991. The examiner issued an Office action on September 4, 1991 denying the conversion on the basis that claims directed to the invention to which the proposed additional inventor, Roger Jeffcoat, contributed were no longer present in the application. It is noted that, but for the absence of claimed subject matter to which Jeffcoat contributed, the conversion request would have been otherwise approved by the examiner.

It should be noted that the PTO was directed by applicants, subsequent to April 19, 1991 but prior to the time the examiner took the case up for further action, to cancel the only claims in the application which included the contribution of proposed inventor Jeffcoat. Petitioner argues that the examiner erred in that the entry should have been approved since, at the time of filing thereof, both sets of claims were still present. Petitioner further indicates that the inventors would be disadvantaged, if the decision of the examiner were to stand unchanged, by virtue of their foreign filings which depend upon this case for foreign priority and which name Jeffcoat as one of the coinventors thereof.

Upon a thorough consideration of the facts, I find that the examiner was not incorrect in his denial of the conversion of inventorship on the basis of the claimed subject matter as it existed at the time of the action on September 4, 1991. It is noted that had the examiner approved the conversion, it would have created an anomalous situation of approval immediately followed by a requirement to amend the inventorship under 37 CFR 1.48(b). The latter requirement would have been necessitated by the cancellation of all claims directed to the contribution of inventor Jeffcoat. It is noted, however, that continued denial of the conversion might inequitably harm applicants.

37 CFR 1.181

Accordingly, this petition is being decided on the basis of the state of the application at the time that the original conversion request was received by the Office, and as such, is granted. Applicants are required, however, to file a petition under 37 CFR 1.48(b) to remove Jeffcoat as an inventor in view of the absence of claims directed to his inventive contribution and to avoid the necessity of making a 35 USC 102(f) rejection of all of the claims remaining in the application.

PETITION GRANTED.

A handwritten signature in dark ink, appearing to read "B. S. Richman", with a long horizontal line extending to the right.

Barry S. Richman, Director
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